

REMARKS/ARGUMENTS

The Examiner has delineated the following inventions as being patentably distinct:

- Group I: Claims 1-16, drawn to a composition;
- Group II: Claim 17, drawn to a polymer obtained via polymerization of the composition;
- Group III: Claims 18 and 19, drawn to laminated glass bonded with the polymerized composition;
- Group IV: Claims 20 and 21, drawn to a method of producing laminated glass; and
- Group V: Claims 23 and 24, drawn to an article comprising the laminated glass.

Applicants provisionally elect, with traverse, the invention of Group I, Claims 1-16, drawn to a composition.

The claims of Groups I-V are integrally linked as composition, product therefrom, and method of making.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required. The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions that the claims of the restricted groups are patentably distinct. Restriction between a process and the product therefrom is proper when other methods can be used to perform that process. Applicants respectfully traverse the Restriction Requirement on the grounds that the Examiner has not provided sufficient reasons or examples to support patentable distinctness.

The Examiner is using U.S. Pat. 5,385,988 to Yamamoto to establish her allegation that Claim 1 of the instant application does not exhibit “special technical features”.

A section 103 determination involves factual determination such as what a prior art patent as a whole discloses; what that prior art in fact discloses to workers in the art; what differences exist between the entire prior art and the whole claimed invention; and what the differences enabled the claimed subject matter as a whole to achieve. The test is not whether each difference individually is obvious; rather, it is whether the claimed invention as a whole is obvious. In deciding obviousness one must look at the prior art from the vantage point in time prior to when invention was made; hindsight obviousness after the invention has been made is not the test. Citing a reference which merely indicates that isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed elements would have been obvious. The fact that a claimed product is within the broad field of the prior art and one might arrive at it by selecting specific items and conditions does not render the product obvious in the absence of some direction or reason for making such selection.

Applicants respectfully traverse on the grounds that the Office has not shown that a burden exists in searching the entire application.

Further, the M.P.E.P. § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

As the Office has not shown evidence that restriction should now be required when the International Preliminary Examination Report did not the Restriction is believed to be improper. 37 C.F.R. § 1.475(b) provides in relevant part that “a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to product, manufacture of said product and use of said product.”

For the reasons recited above, Applicants request that the Restriction Requirement be withdrawn.

Further, Applicants reserve the right to file a divisional application on the non-elected subject matter, if so desired, and be accorded the benefit of the filing date of the present application.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits and an early notice of such action is earnestly solicited.


Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon


Paul J. Killos
Registration No. 58,014